

REMARKS

The following Remarks are submitted in response to the Office Action issued on August 22, 2006 in connection with the above-identified patent application, and are being filed within the statutory period for filing a response. A petition for a one month extension of time is submitted herewith.

Claims 1-3, 5, 8, 9, 13, 14, 16, and 19 remain pending in the present application. Applicant respectfully requests reconsideration and withdrawal of the rejection of the claims, consistent with the following Remarks.

Preliminary, the Examiner has stated that the Declaration filed with the application is defective for the reason that the filing date for the provisional application from which priority is claimed is given in such Declaration as November 14, 2004, when such date should be November 14, 2003. Thus, the Examiner has required a new Declaration. While Applicant acknowledges that the date in the Declaration is in error, Applicant respectfully submits that such error is immaterial and is therefore to be ignored.

In particular, Applicant respectfully points out that the error is immaterial inasmuch as providing such date is not necessary in order to claim priority to such provisional application. In particular, the PTO rules only require that the provisional application be positively identified, which was done here by correctly providing the application number assigned to such provisional application. At any rate, such positive identification need not even be in the Declaration according to the PTO rules, and in this instance such positive identification is also provided with the correct filing date in the specification of the present application, in the section at page 1 thereof entitled "Cross-Reference to Related Application".

Moreover, the PTO did correctly identify the filing date of the provisional application in the filing receipt issued for the present application, and thus cannot be said to have been misled or otherwise confused about the identification of the provisional application. Accordingly, and for all of the aforementioned reasons, and particularly because the Declaration is not even required to refer to the provisional application, Applicant respectfully submits that the Declaration is not in fact defective. Thus, Applicant respectfully declines to submit a new executed Declaration at this time, and requests reconsideration and withdrawal of the requirement for a new Declaration.

The Examiner has now rejected claims 1 and 13 et seq. under 35 USC § 102 as being anticipated by Jenkins et al. (U.S. Patent No. 7,055,914). Applicant respectfully traverses the § 102 rejection and requests reconsideration and withdrawal of same.

Independent claim 1 recites a wheel-balancing weight for being mounted to a wheel with a flange. The weight has a weighted body and a clip securely attached thereto. The body defines a recess therein, and the clip has a securing portion formed to be securely positioned within the recess defined in the body, as well as a grasping portion for securely grasping the flange. The recess of the body allows the clip to be positioned with respect to such body so that the body is in effect shifted toward the mounted-to wheel by way of the recess to achieve a proper fit to the wheel. That is, without the recess, the body would be farther away from the wheel and does not fit as well to such wheel. The securing portion of the clip is secured within the recess by flowing a portion of the body adjacent such clip into contact therewith.

In pertinent part, claim 1 recites that the body has an outboard face for facing away from the mounted-to wheel and an opposing inboard face for facing toward the

mounted-to wheel, and the body defines the recess to extend along the inboard face. That is, to shift the body toward the wheel, the recess is on the inboard side of the body, which faces toward such wheel.

Also, the body has an inner radial face for facing toward an axis of the mounted-to wheel and an opposing outer radial face for facing away from the axis of the mounted-to wheel, and the body further defines the recess to transition from the inboard face and along the outer radial face. The securing portion of the clip includes a substantially planar radial portion positioned within the recess substantially parallel to the inboard face, and a substantially planar axial portion positioned within the recess substantially parallel to the outer radial face. That is, the recess and securing portion of the clip are not only in the inboard face of the body but are also in the outer radial face, which here is by definition the face that extends between the inboard and outboard faces and is exposed away from the axis of the wheel, and is therefore at approximately right angles to the inboard and outboard faces. To summarize, then, the recess and securing portion of the clip are defined to include two portions that are essentially at right angles to each other, one in the inboard face and the other in the outer radial face, all to shift the body toward the wheel.

Independent claim 13 recites the subject matter of claim 1 albeit in the context of a vehicle having the weight of claim 1.

The Jenkins reference discloses in Figs. 6A-6C an embodiment of a wheel-balancing weight with a body having a recess for securing a securing portion of a clip. As can be determined from the orientation of the attaching portion of the Jenkins clip, however, such clip is secured to the outboard face of the Jenkins body, and not the inboard face as is required by claims 1 and 13. In particular, the Jenkins weight as shown in Figs. 6A-6C is

designed to clip to a wheel that would be positioned toward the right in Fig. 6B, and therefore the inboard face of such weight is also to the right in Fig. 6B. Correspondingly, the outboard face is to the left, and since the Jenkins clip is attached to the Jenkins body at the left or outboard face, such Jenkins weight does not disclose a clip attached to a body at the inboard face thereof as is required by claims 1 and 13.

Moreover, the Jenkins reference discloses a weight in Figs. 6A-6C thereof with a clip mounted in a recess of a body, where the recess extends only along an outboard face of the body, and not along an outer radial face of the body, as is required by claims 1 and 13. That is, while the Jenkins body has inner and outer radial faces that face toward and away from an axis of the mounted-to wheel, the Jenkins body defines a recess in the outboard face only and not in the outer radial face, as is required by claims 1 and 13. Correspondingly, the securing portion of the Jenkins clip includes a substantially planar radial portion positioned within the recess substantially parallel to the outboard face (and not the inboard face) but does not have any substantially planar axial portion that is positioned within any recess substantially parallel to the outer radial face, as is required by claims 1 and 13. As a result, the Jenkins recess does not include two portions that are essentially at right angles to each other, one in the inboard face and the other in the outer radial face, all to shift the body toward the recess of the wheel, as is required by claims 1 and 13.

For all of the aforementioned reasons, then, Applicant respectfully submits that the Jenkins reference does not disclose or even suggest the subject matter recited in independent claims 1 and 13 or any claims depending therefrom. Accordingly, and for all the aforementioned reasons, Applicant respectfully submits that the Jenkins reference cannot be

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applied to anticipate or even to make obvious such claims. Thus, Applicant respectfully requests reconsideration and withdrawal of the § 102 rejection.

In view of the foregoing discussion, Applicant respectfully submits that the present application, including claims 1-3, 5, 8, 9, 13, 14, 16, and 19, is in condition for allowance, and such action is respectfully requested.

Respectfully Submitted,

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/Steven J. Rocci/
Steven J. Rocci
Registration No. 30,489

Woodcock Washburn LLP
Cira Centre
2929 Arch Street, 12th Floor
Philadelphia, PA 19104-2891
Telephone: (215) 568-3100
Facsimile: (215) 568-3439